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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,268	11/14/2001	Burkhard Standke	209348US0	6959

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,268

Applicant(s)

STANDKE ET AL.

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 03 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, 16, 27-35, drawn to an oligomeric mixture, classified in class 528, subclass 10.
- II. Claim 15, drawn to a method of making an oligomeric mixture, classified in class 528, subclass 501.
- III. Claims 17-22, 24, and 36-40, drawn to a method of coating/treating a substrate, classified in class 428, subclass 447 and/or classes 427/387 and 522/99.
- IV. Claims 23 and 26, drawn to a binder and its utilization in adhering organic polymers to inorganic substrates, classified in class 156, subclass 329.
- V. Claim 25, drawn to a method of improving rheological properties, classified in class 524, subclass 266.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). The oligomer mixtures of group I could be prepared using propyl group-functionalized silanes bearing any of a number of different hydrolyzable groups besides ethoxy groups or chloro groups, e.g. propyltriacetoxysilane. Moreover, acidic catalysts other than HCl would be effective for promoting condensation of the silane molecules into lower condensates.

Inventions I and III-V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). It is clear from Applicant's own claims that the mixtures disclosed in the claims of group I have a large assortment of possible applications. In addition to the inorganic substrates outlined in the claims, these mixtures could also be employed as treating agents for wood, paper, and molded polymers. They may also be used in the formulation of inks or as modifiers for organic resins used in various industries. In view of the myriad potential uses available for the oligomeric mixtures of group I, the Examiner could easily find art that anticipates, or renders obvious, the composition claims but does not address the methods of use claims of groups III to V. Accordingly restriction of these claims is proper.

Inventions III, IV, and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the inventions defined by groups III to V are deemed unrelated because of the disparate effects that are to be conveyed by each method. For example, one skilled in the art would certainly not predict that a compound known to impart exemplary release characteristics would also be useful in applications that required improved adhesion as the method claim of group IV would suggest. Indeed, there would be little or no expectation that a compound that produces a low energy

Art Unit: 1712

surface upon being polymerized could also be successfully implemented as an adhesive material. The objectives of the subject matter in the claims of Groups III and V are equally dissimilar. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention in group III:

- (a) claims 18 and 20 are directed to a method of protecting buildings and their facades using a formulation containing a mixture of n-propylethoxysiloxane oligomers,
- (b) claim 21 is directed to a method of treating textiles, leather, and cellulose using a formulation containing a mixture of n-propylethoxysiloxane oligomers
- (c) claim 22 is directed to a method of coating glass fibers using a formulation containing a mixture of n-propylethoxysiloxane oligomers,
- (d) claim 24 is directed to a method of modifying surface fillers with a mixture of n-propylethoxysiloxane oligomers, presumably for the purpose of preventing structuring in, or increasing the compatibility of the filler with, a polymer matrix to which the filler has been added.

Clearly, these species are, on their face, patentably distinct insofar as any suggestion to, for example, use the instant composition for treating building materials would not serve to motivate one of ordinary skill to use the same as a treating agent for

fillers. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Claim 17 is generic to claims 18, 20, 22, and 24 (but not to claim 21 as the substrates disclosed therein are not comprised of inorganic matter).

As an aside, Applicant seems to purport that, because all of the claims including the method claims described above are dependent from product claim 1, that restriction is somehow unmerited. The Examiner vehemently disagrees with this assertion as restriction practice is perfectly justifiable even in those cases where there is only a single independent claim provided that the Examiner illustrates how one invention might easily be avoided when searching another. The Applicant has contemplated a variety of end-uses that exploit different beneficial properties of the product mixture. That is, the properties of the oligomer mixture advantageous for improving rheological properties are not necessarily those needed for imparting oleophobic characteristics. For this reason and others, it is the Examiner's position that restriction is proper in this case.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers

Art Unit: 1712

for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

November 12, 2002


MARGARET G. MOORE
PRIMARY PATENT EXAMINER
ART UNIT 1712